



JPW

PATENT
Customer No. 22,852
Attorney Docket No. 7707.0020-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Michael K. MAXWELL et al.) Group Art Unit: 1732
)
Application No.: 10/000,148) Examiner: Stefan Staicovici
)
Filed: December 4, 2001)
)
For: A MOLDED COMPOSITE)
STRUCTURE AND METHOD OF)
FORMING SAME)

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a restriction requirement dated September 29, 2003, Examiner M. J. Carrone required restriction under 35 U.S.C. § 121 between Group I (Claims 1-21, 43, 45-66, and 89), Group II (Claims 22-42, 44, 67-88, and 90), and Group III (Claims 91-100). On October 17, 2003, Applicants responded to this restriction requirement by electing to prosecute the claims of Group I. On February 18, 2004, the present Examiner, however, withdrew the previous restriction requirement and issued a new restriction requirement requiring restriction under 35 U.S.C. § 121 between Group I (Claims 1-21 and 45-66), Group II (Claims 22-42, 44, 67-88, and 90), Group III (Claims 91-100), and Group IV (Claims 43 and 89). On March 12, 2004, Applicants responded to this second restriction requirement by traversing the restriction requirement between Groups I and IV and requesting that it be withdrawn so that Applicants would be able to elect the

claims of Groups I and IV. On June 3, 2004, in view of Applicants' traversal, the present Examiner withdrew the second restriction requirement and issued a third restriction requirement again requiring restriction under 35 U.S.C. § 121 between Group I (Claims 1-21 and 45-66), Group II (Claims 22-42, 44, 67-88, and 90), Group III (Claims 91-100), and Group IV (Claims 43 and 89). For the reasons stated below, Applicants again respectfully traverse the restriction requirement between Groups I and IV and request that it be withdrawn so that Applicant will be able to elect the claims of Groups I and IV together.

The Examiner asserts that claims 1-21 and 45-66 (Group I) and claims 43 and 89 (Group IV) are "related as combination and subcombination" but are "distinct." The Examiner further asserts that the "subcombination has separate utility such as a simple computer readable medium to be used in a computer system to store data and not to control a molding process." Applicants respectfully traverse the restriction requirement for the following reasons.

The computer readable medium claims of Group IV clearly do not have a separate utility outside of the practice of the method claims of Group I. In fact, claims 43 and 89 recite a computer readable medium containing instructions for controlling a computer system to perform methods that are identical to those recited in Claims 1 and 45, respectively. Since these claims refer to the exact same methods, they are not distinct and cannot be restricted from one another according to the restriction practice set forth in the MPEP.

In the Office Action, the Examiner cited M.P.E.P. § 806.05(c) and asserted that combination-subcombination inventions "are distinct if it can be shown . . . that the

subcombination has utility by itself or in other combinations.” The Examiner, however, has failed to identify any separate utility for the computer readable medium claims. The Examiner stated only that the computer readable medium could be used in a computer system to store data and not to control a molding process. However, rather than claiming any computer readable medium, the claims of Group IV concern a computer readable medium containing instructions to perform the manufacturing method claimed in Group I. The Examiner has not explained how a computer readable medium containing instructions to perform a method has any utility outside of the performance of that claimed method. Therefore, the restriction requirement should be withdrawn.

Finally, even if the claims of Groups I and IV could be considered distinct, “[i]f the search or examination of [the] application can be made without serious burden, the examiner must examine it on the merits.” MPEP § 803 (emphasis added). The searches for each of Groups I and IV would necessarily overlap one another due to the common claimed subject matter. Thus, the examination of these claims together would not result in any additional burden to the Examiner. Consequently, the restriction requirement between Groups I and IV is improper and should be withdrawn.

For all the above stated reasons, Applicants respectfully request that the Examiner withdraw the restriction requirement between claims 43 and 89 of Group IV and claims 1-21 and 45-66 of Group I so that Applicants will be able to elect Groups I and IV together. If the Examiner agrees to that modification, Applicants provisionally elect to prosecute Groups I and IV. If, on the other hand, the Examiner insists on maintaining the restriction requirement and refuses to modify it as suggested, Applicants provisionally elect Group I with traverse and respectfully request that the

Examiner make the restriction final as soon as possible so that Applicants will have an opportunity to file a petition requesting the Group Director to review the restriction requirement.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: June 29, 2004

By: 

D. Brian Kacedon
Reg. No. 46,814